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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/003,812	01/07/1998	SATOSHI BAN	041-1987	9498

7590

11/05/2002

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EXAMINER

GRIER, LAURA A

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/003,812

Applicant(s)

BAN ET AL.

Examiner

Laura A Grier

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Young III in view of Porco, U. S. Patent No. 4873712.

Regarding **claim 8**, Young, III discloses an integrated sound/telephone headset system. Young, III disclosure teaches dual communication between an audio source and telephone using earphones and/or headset. (Figures 1-3 and abstract). Young's disclosure inherently teaches the connection of a first plug and a second plug connectable between an audio device and portable communication device, respectively (figures 1-3 and col. 2, line 2, lines 45-49); a speaker (44) which is indicative of a electroacoustical transducer connected to the first and second plug. Further, Young, III provides teachings of the control box as means for generating a detection signal of the telephone, and for disconnecting the first plug and connecting the first plug (col. 4, lines 39-41, 64-67, and col. 5, lines 1-7). However, Young's system function based upon a physical manipulation of the microphone and/or the hand receiver of the telephone for the disconnection between the two devices and thus fails to disclose automatic disconnection of the plugs. The examiner maintains that automatic disconnection capabilities were well known in the art.

Regarding the automatic disconnection capabilities, in a similar field of endeavor, Porco discloses a telephone controller interrupter circuit. Porco's teaches the automatic disconnection of an audio device for the purpose of receiving and/or answering a telephone when indicated by ring signal which controlled by a switching circuit (abstract, figures 1 and 2, and col. 3, lines 24-55).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Young by implementing the means of automatic disconnection and/or disablement of the audio for the purpose of the enabling a user to use the telephone with extraneous noise or unwanted sounds of the audio while in conversation and further the automatic disconnection means enables more convenience for the user of the devices and in some cases, while being used in a vehicle, safety. Further, such alternate capabilities, e.g. automatic means or functions are supported by *In re Venner*, 120 USPQ 192, MPEP 2144.04, wherein automatic means to replace manual functions is well known to one skill in the art for providing the same function or end result.

Regarding **claim 10**, Young and Porco discloses everything claimed as applied above (see claim 8). Further, Young, III inherently discloses a microphone and a switch all in relation to the function of the control box (col. 3, lines 52-53).

***Allowable Subject Matter***

**Claim 9** is allowed.

*Citations of Pertinent Prior Art*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hayes et al., U. S. Patent No. 5867794, discloses audio-output for a portable radio telephone utilizing a vehicle's AM/FM radio.

*Response to Arguments*

5. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

The applicant essential argue the prior art fails to specifically disclose the automatic switching functionality of the invention. The examiner has provided support of the automatic function in Porco that teaches automatic switching and/or disconnection capabilities.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A Grier whose telephone number is (703) 306-4819. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Or faxed to:**

Art Unit: 2644

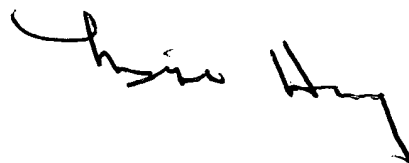
**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

LAG

October 22, 2002



**MINSUN OH HARVEY  
PRIMARY EXAMINER**